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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,225	08/31/2000	Bharat M. Chowrira	MBHB00-882-C (250/131)	4785

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EXAMINER	
EPPS, JANET L	

ART UNIT	PAPER NUMBER
1635	11

DATE MAILED: 05/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.	Applicant(s)
09/653,225	CHOWRIRA ET AL
Examiner	**Art Unit**
Janet Epps	1635

Office Action Summary

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-30* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4)☐ Interview Summary (PTO-413) Paper No(s).
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-15, and 25-30 are drawn to enzymatic and antisense nucleic acid molecules, wherein said nucleic acid molecules comprise any of the sequences defined in tables III-VII, and cells comprising said nucleic acid molecules, classifiable 536/24.5 and 435/325.

   II. Claims 16-24, drawn to methods of inhibiting telomerase enzyme activity in a cell, and treating a patient having a condition associated with the level of TERT, classifiable in 514/44.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the enzymatic and antisense nucleic acid molecules of Invention I may be used as probes in a method for detecting the presence of TERT mRNA in a sample.

3. In addition to the restriction set forth above, pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the enzymatic and antisense nucleic acid molecules listed in the instant claims are further subject to restriction.

Claim 1, and those claims dependent thereon, are drawn to enzymatic nucleic acid molecules comprising any of the ribozyme sequences defined in tables III, IV, V, and VII. These

tables, in combination, recite over 2,000 individual sequences. Claim 3, and those claims dependent thereon, recite enzymatic nucleic acid molecules comprising any of the DNAzyme sequences defined in table VI, which comprises about 947 individual sequences. Claim 4 is drawn to an enzymatic nucleic acid molecule comprising sequences that are complementary to any of substrate sequences defined in tables III-VI, again corresponding to over 2,000 individual sequences. Claim 5 is drawn to an antisense nucleic acid molecule comprising a sequence complementary to any of the substrate sequences shown in Tables III-VI. The substrate nucleic acid sequences and ribozyme sequences set forth-in Tables III-VII comprises over 2,000 individual sequences combined. Each of these nucleotide sequences are considered to be structurally independent and distinct even though they each target the same gene, since each of these nucleic acid molecules have a unique nucleotide sequence and each targets a different and specific region of the gene. Furthermore, a search of all the nucleotide sequences in Tables III-VII recited in claims 1, 3-5, and those claims dependent thereon, presents an undue burden on the Patent and Trademark Office to search and examine all of the recited sequences.

As per M.P.E.P. 2434, "the Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such nucleotide sequences to be claimed in a single application. Under this policy, in most cases, up to 10 independent and distinct nucleotide sequences will be examined in a single application without restriction. Those sequences which are patentably indistinct from the sequences selected by the applicant will also be examined." In view of the foregoing, in addition to electing either invention II or I, applicants are required to elect up to 10 nucleotide sequences from Tables III-VII.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined, and an election of up to 10 representative nucleic acid molecules from Tables III-VII to be searched with the elected invention, even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objection

6. Claims 1, 3-5, and 25-28 reference one or more of tables III-VII. The instant claims are objected to for failing to recite the appropriate sequence identifiers. According to 37 CFR 1.821 through 1.825, Applicants are required to assign a sequence identifier (SEQ ID NO) for every disclosed unbranched nucleic acid sequence of 10 or more nucleotides and list these sequences individually in a Sequence Listing as a separate part of the disclosure.

Additionally, see MPEP § 2173.05(s) which states "[w]here possible, claims are to be complete in themselves. Incorporation by reference to a specific figure or table "is permitted only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim." In the instant case, according to the sequence rules under 37 CFR 1.821-1.825, the appropriate sequence identifier, i.e. SEQ ID NO, should reference sequences recited in a claim.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L Epps whose telephone number is 703-308-8883. The examiner can normally be reached on Mondays through Friday, 9:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703)-308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Janet L. Epps, Ph.D.
Patent Examiner
May 16, 2002